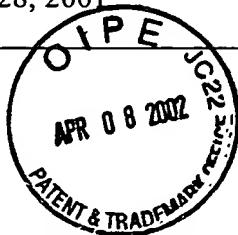


In re: Cann et al.  
Appl. No.: 09/893,928  
Filed: June 28, 2001  
Page 2 of 5



### REMARKS

Reconsideration of the above-identified application is respectfully requested.

Claims 1 through 27 are currently pending in the application. Claim 16 of the application stands allowed. Claims 7, 10 and 15 have been amended to be more definite.

Claims 5, 6, 9, and 19-23 are objected to as being dependent upon a rejected base claim. As shown below, each base claim of the application has been shown to be allowable, therefore, Claims 5, 6, 9, and 19-23 are now allowable. Similarly, Claims 7 and 15 are indicated as allowable if rewritten to be more definite and to include the limitations of base claims and intervening claims. As mentioned, Claims 7 and 15 have been rewritten to become more definite and the base claims and intervening claims of the application have been shown to be allowable. Therefore, Claims 7 and 15 are now allowable.

### Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 7, 10 and 15 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Each of Claims 7, 10 and 15 have been amended to overcome the indefiniteness rejection and are now believed to be allowable.

### Rejections Under 35 U.S.C. § 103

Claims 1-4, 8, 10-14, 17, 18, and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iida et al. The Office Action states that Iida discloses an apparatus and method for recycling slurry comprising a number of conduits, filters, and tanks, but that Iida does not disclose the specific location of the filters and tanks as claimed in the application. Although the components of the Iida apparatus are not assembled in the same manner as the claimed invention, the Office Action finds the claimed invention obvious on the grounds that the specific location of the filters and tanks, the specific flow rate and pressure of the pump, and size of the filters would have been obvious to one having ordinary skill in the art.

The claimed invention is not obvious in light of Iida et al. because, among other reasons, the proposed modification of Iida would render the Iida reference unsatisfactory for its intended

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purpose. The claimed invention recites the location of a second filter between a dirty slurry storage tank and a clean slurry storage tank (Claim 1, lines 6-11; Claim 16, lines 14-17; and Claim 17, lines 38-2). Conversely, the Iida reference discloses the use of a filter 7 between a clean slurry storage tank 60 and a slurry feed apparatus 300. If the filter of Iida were repositioned between the dirty slurry storage tank 121 and the clean slurry storage tank 60 of Iida, the filter 7 would be unable to accomplish its intended purpose of filtering out the small foreign matter mixed in the slurry S sent from the concentration adjusting tank 6 (Col. 6, lines 37-40).

Since the proposed modification of the Iida reference would render it unsatisfactory for its intended purpose, the Iida reference cannot properly be relied upon to reject the claimed invention. In this regard, if a proposed modification to a prior art technique would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) [MPEP 2143.01]. *In Re Gordon* dealt with an invented blood filter assembly having an inlet and outlet on the bottom of the assembly and a gas outlet at the top of the assembly. The prior art was a gasoline filter having an inlet and outlet at the top of the filter and an outlet for dirt and water removal at the bottom of the assembly. The blood filter was found to be patentably distinct from the prior art gas filter since, if the gas filter were reoriented to resemble the blood filter, the gas filter would have been inoperable for its intended purpose.

Because location of the filter 7 within the Iida apparatus serves a particular purpose, namely, filtering out the small foreign matter mixed in the slurry sent from the concentration adjusting tank, relocation of the filter to a location which negates that purpose would not have been obvious to one having ordinary skill in the art. Because the Iida reference, therefore, does not teach or motivate one to construct the claimed invention, the claimed invention is patentably distinct from the Iida reference and the 103(a) rejection is therefore overcome.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

In re: Cann et al.

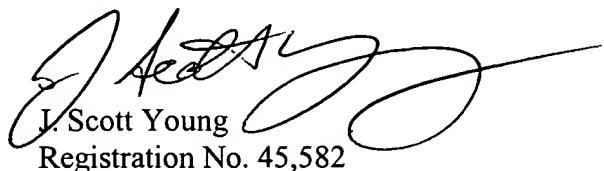
Appl. No.: 09/893,928

Filed: June 28, 2001

Page 4 of 5

therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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Registration No. 45,582

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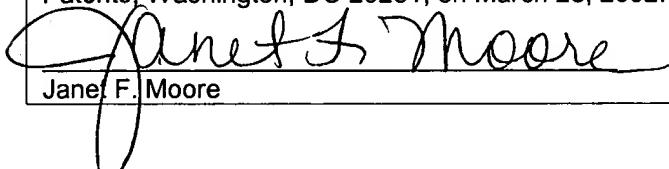
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on March 28, 2002.



Janet F. Moore

**Version with Markings to Show Changes Made:**

**In The Claims**

7. (Once Amended) The apparatus for recycling slurry of claim 5, wherein the clean slurry storage tank and the dirty slurry storage tank are portions of a single vessel separated by a partition having a top edge, wherein the top edge of the partition acts as the overflow relief conduit.

10. (Once Amended) The apparatus for recycling slurry of claim 1, further comprising at least one device selected from a [the] group consisting of pH adjusters, slurry concentration adjusters, deionization units, and combinations thereof.

15. (Once Amended) The apparatus for recycling slurry of claim [1] 9, further comprising an additional filter having an inlet and outlet and [.] valves at the inlet and outlet of the additional filter, [and valves at the inlet and outlet of the second filter,] wherein said additional filter resides in parallel to said second filter, and wherein said additional filter also removes particulates of a second predetermined size.